

Remarks

Applicant expresses appreciation to the Examiner for the consideration of the subject patent application. Claims 1-6, 20 and 21 stand rejected under Section 103 over Hatano, *et al.* U.S. Patent No. 5,741,028 (hereinafter "Hatano"). Claims 7-19 stand rejected under Section 103 over Hatano in view of Lee, *et al.* U.S. Patent No. 5,947,279 (hereinafter "Lee").

The following discussion shall be directed to the issues raised as pertinent to the independent claims of the application. It is recognized that the issues raised by the Examiner pertaining only to dependant claims are addressed by discussions regarding the independent claims, as they are in this case rendered moot if the independent claim(s) are found allowable. In this application, the dependant claims are more narrow in scope than the independent claims from which they depend, and the issues of patentability raised regarding them are not related to formal matters bearing on patentability outside patentability of the independent claims in each case.

First, regarding the rejection of claims 1-6, 20, 21 over Hatano, applicant has reviewed the cited reference and has found no teaching regarding size of the sheets (documents) to be accommodated. Certainly, there is no teaching of accommodating a 12"x12" scrapbooking standard size. *Long size*

Further, it appears that the document teaches away from accommodating a 12"x12" size. The reference teaches a file folder configuration that, in a first state (FIGs. 1 and 2), is fairly conventional. However, it also has a second state (FIGs. 3,4,5) accomplished by pulling upward on a tab 301 positioned at the top of the last (rear-most) file folder. The result is that the folders, which are interconnected by tongues 33, are picked up sequentially, back to front, to display in a cascaded configuration (*e.g.* FIG. 5). Nevertheless, the file folders themselves are apparently each the same size, and configured as shown in FIG. 4. These appear to be configured for conventional letter or legal size paper, and the written specification is silent on the matter of size. Parenthetically, note that the tabs of the folders have the same reference (33) as the tongue 33,

33'; an apparent error, and the tabs are not referred to in the specification as far as Applicant can discern.

Moreover, while the reference does cite that there are prior art file folders made of a transparent plastic, nowhere does it teach that the device taught in this reference is made of a clear material (or a plastic material). On the contrary, insofar as it teaches anything on this point it is either ambiguous, or that the material is opaque. In fact, the teachings of the reference about the Hatano configuration suggest that it is adapted to make the contents visible by pulling up on the tab 301, revealing the contents of each folder because the front wall is shorter than the rear wall of each folder, and the cascading effect mentioned reveals the contents by shifting the folders with respect to each other over a distance, in each case, corresponding to the difference in height of the front and back walls of each folder 30. Thus, the configuration is particularly suited to see the contents of folders which are made of a material that is not transparent; and the burden of the disclosure is that this is patentably different from providing for viewing "through" the transparent walls of prior art file folders.

In contrast, claims of the present application set forth that the organizer is configured to accommodate 12"x12" scrapbooking paper in an unfolded condition. This element is not taught in Hatano. They also set forth that at least one wall of the organizer be translucent or see-through so that contents can be appreciated through the wall. The Hatano reference teaches away for the reasons set forth above, and more particularly for the reasons which follow and which also bear on the rejections of claims 7-19.

Accordingly, applicant requests reconsideration and withdrawal of the rejection for at least the reason that the Hatano does not teach or suggest the combination set forth in the claims, and in fact teaches away.

The rejection of claims 7-19 is based at least in part upon assertions regarding the Hatano disclosure which are not supported by the Hatano disclosure, this is for at least the reasons set forth above. Therefore they should be withdrawn for at least the reasons set out above.

Moreover, these rejections are specifically predicated on the presumption that the walls of the Hatano device are transparent and that a pocket can be seen when the Hatano device is closed (last full sentence of p. 3 of the Office Action). This is, in fact, directly against the teachings of the Hatano reference. As mentioned, there is no teaching that the walls of the folders are or can be clear. The drawings are ambiguous on this point. FIG. 4 shows the tongue 33 as a hidden line, unambiguously teaching an opaque material of construction for the folders 30. FIG. 3 shows, in an exploded view, the tongue (here 33') in front of the folder 30' or at least, it must be said, so that it cannot reliably be determined whether it is in front or in back of the front-most folder 30'. To have it in front of the folder does not correspond with the written description; which teaches that it is tucked in the folder behind. To have it behind the folder is inconsistent with FIG. 3 which shows it as a solid line and therefore in front of the folder. The other folders are shown in phantom where they overlap, and if the tongue behind the front-most folder and tucked into the folder behind, it should be shown shorter, and also be shown in phantom. In sum, there is no clear teaching that the folders are clear, and the inconsistent use of line type de-clarifies the issue further (sorry about the pun).

Assuming, for the sake of argument only, and without waiver or admission, that the reference teaches that the folders 30 can be made of a clear material by virtue of the use of the phantom lines in FIG. 3, Hatano then teaches away from a clear or translucent material for construction of the walls 11, 12, 13, 14, and cover 15 of the body 10. The walls and cover unambiguously hide structure that they overlay; and this is consistent throughout the figures. The patent thus teaches that you cannot see the pocket 11 through the cover 15 for example, if you are to take the position that the phantom lines in FIG. 3 indicates a clear or translucent structure. If you take the position that the line type in FIG. 3 should be ignored, then for the reasons set out above the only conclusion, still, is that an opaque material is intended to be shown in the figures. In other words, take either of the two possible assumptions as true, and either way you have to conclude that the patent teaches an opaque material for the body 10 because it clearly shows it as opaque (sorry, no pun intended that time) in the figures (and as

mentioned, several times, there is no teaching in the written specification on the point). If and insofar as it teaches anything on the subject of clear vs. opaque material for the Hatano device, the written description teaches viewing the contents of the device by a means different from that of the prior art, which is said to be the use of a clear material to appreciate contents. Thus opaque material should be inferred, if anything.

Applicant acknowledges that clear materials are known. What applicant points to as a misreading of the Hatano reference is the assertion that it teaches the *combination* of elements put forward by the Examiner. It mentions clear materials as the prior art, then goes in a different direction entirely, and teaches a combination entirely different from that set forth in the claims of this application.

In any event, for at least these reasons, reconsideration of the rejections of claims 7-19 as based at least in part on the assumptions that Hatano teaches accommodation of "any size" including 12"x12" scrapbooking paper, in an unfolded condition, and that the material from which it is made is transparent, is respectfully requested. Moreover the rejection should be withdrawn because the Hatano and Lee references together do not teach or suggest all the elements of the combinations and method steps set forth in the claims.

Further, anticipating that the issue of whether making a organizer having all the elements of the combination would be obvious based on the cited references and the general knowledge and skill in the art, applicant has the following observations. First, prior to applicant's invention, scrapbookers for several years used portfolios, opaque scrapbooking boxes and cases, and other means to store, transport and organize scrapbooking materials having the oversized 12"x12" configuration. Second, Applicant's invention and market introduction of a scrapbooking organizer made of archival poly and configured specifically to accommodate scrapbooking materials, and particularly 12x 12 paper, was very well received. And third, other manufacturers followed suit with similar products within a short time period. There was a long-felt need, which went unfilled for considerable time (a matter of years, not months) after 12"x12" paper was introduced and became popular in scrapbooking, that was filled by the invention. Other

practitioners in the art, makers of scrapbooking products, followed applicant's lead and introduced similar products after Applicant's products were marketed. Further evidence regarding secondary indicia of non-obviousness can be supplied, in such form as the Examiner may request.

However, it is the position of Applicant that the reasons and arguments set forth above regarding non-obviousness over the cited references are sufficient for withdrawal of the rejections; and that the claims, as they stand, are patentable over the art of record. As mentioned, though the specific rejections of dependant claims have not been discussed, the dependant claims are patentable for the same reasons that the independent claims are patentable.

The Examiner is invited to call the undersigned representative of the Applicant at (801) 566-6633 if there is any question or concern regarding this matter.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 20-0100.

DATED this 7th day of April, 2003.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Clifton W. Thompson", with a checkmark above the end of the signature.

Clifton W. Thompson
Attorney for Applicant
Registration No. 36,947

THORPE, NORTH & WESTERN, L.L.P.
P.O. Box 1219
Sandy, Utah 84091-1219
Telephone (801) 566-6633